

From the INTERNATIONAL BUREAU

PCTNOTIFICATION CONCERNING
TRANSMITTAL OF COPY OF INTERNATIONAL
PRELIMINARY REPORT ON PATENTABILITY
(CHAPTER I OF THE PATENT COOPERATION
TREATY)

(PCT Rule 44bis.1(c))

To:

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MARSHALL GERSTEIN

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23 March 2006 (23.03.2006)

Applicant's or agent's file reference

29757/P-888A/PC IGTIP 208W0

IMPORTANT NOTICE

International application No.

PCT/US2004/029906

International filing date (day/month/year)

14 September 2004 (14.09.2004)

Priority date (day/month/year)

15 September 2003 (15.09.2003)

Applicant

IGT et al

The International Bureau transmits herewith a copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)

BEYER WEAVER & THOMAS, LLP

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BY DOCKETING DEPT.

DATE: 5/16 BY: CW

TJS

The International Bureau of WIPO
34, chemin des Colombettes
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Authorized officer

Beate Giffo-Schmitt

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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 29757/P-888A/PC	FOR FURTHER ACTION	See item 4 below
International application No. PCT/US2004/029906	International filing date (<i>day/month/year</i>) 14 September 2004 (14.09.2004)	Priority date (<i>day/month/year</i>) 15 September 2003 (15.09.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant IGT		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).
2. This REPORT consists of a total of 7 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.
3. This report contains indications relating to the following items:

<input checked="" type="checkbox"/> Box No. I	Basis of the report
<input type="checkbox"/> Box No. II	Priority
<input type="checkbox"/> Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/> Box No. IV	Lack of unity of invention
<input checked="" type="checkbox"/> Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/> Box No. VI	Certain documents cited
<input checked="" type="checkbox"/> Box No. VII	Certain defects in the international application
<input type="checkbox"/> Box No. VIII	Certain observations on the international application
4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 16 March 2006 (16.03.2006)
Facsimile No. +41 22 740 14 35	Authorized officer <div style="text-align: center; font-weight: bold;">Beate Giffo-Schmitt</div>
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PATENT COOPERATION TREATY

REC'D 20 JAN 2005

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From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

see form PCT/ISA/220

3/3

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing

(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION

See paragraph 2 below

International application No.
PCT/US2004/029906

International filing date (day/month/year)
14.09.2004

Priority date (day/month/year)
08.07.2004

International Patent Classification (IPC) or both national classification and IPC
G07F17/32

Applicant
IGT

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2004/029906

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2004/029906

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-59
	No: Claims	
Inventive step (IS)	Yes: Claims	
	No: Claims	1-59
Industrial applicability (IA)	Yes: Claims	1-59
	No: Claims	

2. Citations and explanations

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/US2004/029906

Re Item I

Basis of the report

1. Prior Art

Reference may be made to the following documents:

- D1: EP-A-0 769 769 (BALLY GAMING INT INC) 23 April 1997 (1997-04-23)
- D2: US-B1-6 168 521 (BUNCE ART ET AL) 2 January 2001 (2001-01-02)
- D3: WO 96/18174 A (HENWOOD GEOFFREY VAUGHAN ; HUMPHRIES SCOTT
MICHAEL (AU)) 13 June 1996 (1996-06-13)
- D4: US 2001/036855 A1 (MEEKINS JOHN P ET AL) 1 November 2001
(2001-11-01)

2. Summary

The application does not meet the requirements of the PCT because the claims do not comprise an inventive step within the meaning of Article 33(3) PCT. Further, the claims are not clear within the meaning of Article 6 PCT.

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability

3. Inventive Step

The claims relate to a large extent to rules for playing games within the meaning of Rules 39.1(iii) and 67.1(iii) PCT. Because neither the ISA nor any IPEA is required to perform a search or examination of these matters in accordance with Articles 17(2)(a)(i) and 34(4)(a)(i) PCT, respectively, these rules for playing games cannot contribute to an inventive step of the claims concerned.

The claims do have some technical aspects or features. Some of these features are listed:

3.1 Gaming Devices

The gaming devices as claimed or even as described do not go beyond the features of a normal computer properly programmed and set up to play wagering games (RAM, ROM, Processor, Hard Disk, Data and Address Bus, communication interfaces, etc.). Such computers are well-known before the priority date of the present application. Their existence on that date requires no further evidence. Thus, such features cannot add to the inventiveness of any claim.

Further, the application discloses coin validators, bill acceptors, card readers and the like in combination with gaming devices. Such combination is disclosed by D1, figure 1 thereof. This figure also discloses a network interface for a gaming machine, as well as a host computer, corresponding to the described network computer. Reference is also made to figures 3 and 4 of D4.

3.2 Network Computers

Similar reasoning is provided for the network computer. Such computers and the network attached to them are also well known, no further evidence of their existence is required. Such a network computer cannot add to the inventiveness of any claim.

3.3 Linking two Gaming Networks

What does not seem to be claimed but is described in figure 1 of the application is the linking of two remotely distant gaming network over a third network. This, however, is known from figure 2 of D3. Therefore, even if such a subject-matter were claimed, it would be known. This cannot add to inventiveness, either.

3.4 Considering the above, the difference between the subject-matter of the independent claims and the closest prior art as described under sections 3.1 - 3.3 are the rules for playing the game. In this specific case, and considering that the gaming machines are essentially computers, the implementation of these rules for playing games is

essentially an act of programming. The relevant person skilled in the art would therefore be a computer programmer.

As indicated under section 3.1, above, rules for playing games may be excluded from search and examination as they are not technical. Therefore, they cannot constitute a technical problem. However, having such technical problem and solving it in a way which is not obvious to a person skilled in the art is an essential for including an inventive step. Therefore, rules for playing games cannot contribute to the technical character of a claim, and consequently cannot contribute to an inventive step of that claim.

However, implementing the rules for playing the game on the machines as described or claimed is a technical problem which is suitable for the problem-and-solution approach. Considering the closest prior art is a gaming machine and network as described in sections 3.1 - 3.3, this problem would be solved by the person skilled in the art of programming computers in any given way. Therefore, the claims do not include an inventive step within the meaning of Article 33(3) PCT.

- 3.5 The ISA could not establish any subject-matter in the application which could be considered to provide an inventive step. Such matter would have to be both not excluded by Rules 39.1(iii) and 67.1(iii) PCT and, additionally, not known from prior art documents. It is therefore not clear what part of the application might lead to a positive assessment with regard to novelty and inventive step.

Re Item VII

Certain defects in the international application

4. Clarity: Unreasonable Amount of Independent Claims

The application contains 2 independent method claims and 2 independent system claims. This is not reasonable within the meaning of Rule 6.1(a) PCT, and therefore renders the set of claims unclear within the meaning of Article 6 PCT.